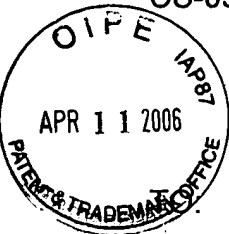


DFW

CS-03-026

Application no. 10/734,423

April 3, 2006



Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 2826 - Examiner: Leonardo Andujar

FROM: George O. Saile, Reg. No. 19,572
28 Davis Avenue
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/734,423
File Date: 12/12/03
Inventor: Fan Zhang et al.
Examiner: Leonardo Andujar
Art Unit: 2826
Title: A NEW DESIGN AND METHOD OF FABRICATION OF A DIE
OXIDE RING

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated 03/14/06. In that office action, restriction was required to one of the following Inventions under 35 U.S.C. 121:

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on April 5, 2006.

Signature _____
Stephen B. Ackerman, Reg. No. 37,761

Date: 4/8/06

The inventions stated are:

I - Claims 8-9 drawn to a semiconductor device, classified in class 257, subclass 700, and

II - Claims 1-7, drawn to a method of manufacturing a semiconductor device, classified in class 438, subclass 117.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group II - Claims 1-7 drawn to a process classified in Class 438, subclass 117. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to "a method for creation of an oxide ring surrounding a guard ring of a semiconductor die", and that the product claims are directed to "an oxide ring surrounding a guard ring of a semiconductor die ", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of

search must necessarily cover both the process class/subclass 438/117 and product class/subclass 257/700, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, unpatentability of the Group I invention would not necessarily imply unpatentability of the Group II invention, because the device of Group I invention could be made by a process materially different from that of the Group II invention. For example, the process of claim 4 can be materially altered by singulating the substrate into semiconductor die by using a laser or a liquid jet cutting process" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,



Stephen B. Ackerman, Reg. No. 37,761